No. 17-571

IN THE

Supreme Court of the United States

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,

Petitioner,

v.

WALL-STREET.COM, LLC, *et al.*,

Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE ELEVENTH CIRCUIT

BRIEF OF AMICUS CURIAE THE INTERNATIONAL TRADEMARK ASSOCIATION IN SUPPORT OF PETITIONER

NOEL M. COOK
OWEN WICKERSHAM & ERICKSON, P.C.
455 Market Street, Suite 1910
San Francisco, CA 94105
(415) 882-3200

LAWRENCE K. NODINE
Counsel of Record
BALLARD SPAHR LLP
999 Peachtree Street
Atlanta, Georgia 30309
(678) 420-9300
nodinel@ballardspahr.com

JASON P. BLOOM
HAYNES AND BOONE, LLP
2323 Victory Avenue, Suite 700
Dallas, Texas 75219
(214) 651-5000

Counsel for Amicus Curiae The International Trademark Association

283167

COUNSEL PRESS
(800) 274-3321 • (800) 359-6859

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES ii

INTEREST OF THE AMICUS CURIAE 1

SUMMARY OF ARGUMENT 6

ARGUMENT 7

A. Because the meaning of Section 411(a) is unclear, the Court should construe the statute to be consistent with the intent of Congress to adhere to international treaties, in this case Berne. 7

B. The registration interpretation is contrary to Berne. 9

C. The registration interpretation deprives copyright owners of important enforcement rights. 14

D. Requiring the issuance or denial of a registration decision is bad policy and makes no practical sense. 20

E. The plain language of the Copyright Act supports the application interpretation. 24

CONCLUSION 26

TABLE OF AUTHORITIES

Page(s)

Cases

ATCS Int'l LLC v. Jefferson Contracting Corp.,
807 F. Supp. 2d 516 (E.D. Va. 2011) 22

Benz v. Compania Naviera Hidalgo, S.A.,
353 U.S. 138, 77 S. Ct. 699, 1 L. Ed. 2d 709 (1957) 9

Clonus Assocs. v. DreamWorks, LLC, 417 F. Supp. 2d 248 (S.D.N.Y. 2005) 19

Garcia v. Google, Inc.,
786 F.3d 733 (9th Cir. 2015) 19

Golan v. Holder,
565 U.S. 302, 132 S. Ct. 873, 181 L. Ed. 2d 835 (2012) 8

Murray v. Schooner Charming Betsy,
6 U.S. (2 Cranch) 64 (1804) 8

Petrella v. Metro-Goldwyn-Mayer, Inc.,
134 S. Ct. 1962, 188 L. Ed. 2d 979 (2014) 17

Robinson v. Shell Oil Co.,
519 U.S. 337, 117 S. Ct. 843, 136 L. Ed. 2d 808 (1997) 7

Subafilms, Ltd. v. MGM-Pathe Commc'ns Co., 24 F.3d 1088 (9th Cir. 1994) (en banc) 8

Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc., 618 F.3d 417 (4th Cir. 2010) 22

Vimar Seguros y Reaseguros, S.A. v. M/V Sky Reefer, 515 U.S. 528, 115 S. Ct. 2333, 132 L. Ed. 2d 462 (1995) 9

Washingtonian Publ'g Co. v. Pearson, 306 U.S. 30, 59 S. Ct. 397, 83 L. Ed. 470 (1939) 13

Statutes

Copyright Act of 1976, Pub. L. No. 94-553, § 101, 90 Stat. 2541 (17 U.S.C. 101 *et seq.*) ..... *passim*

15 U.S.C. § 1125 14

17 U.S.C. § 302(a) 11, 13, 25

17 U.S.C. § 408(a) 11, 13, 25

17 U.S.C. § 410(c) 22

17 U.S.C. § 411(a) ..... *passim*

17 U.S.C. § 507 17

Other Authorities

Annual Report 4,
https://www.copyright.gov/reports/annual/2017/ar2017.pdf 21

Fees,
https://www.copyright.gov/about/fees.html#handling (last visited August 31, 2018) 13

INTA Mission Statement,
http://www.inta.org/Governance/Pages/StrategicPlan.aspx 3

Melville B. Nimmer, NIMMER ON COPYRIGHT, § 7.16[B][3][b][ii] 21

Note, *The Charming Betsy Canon, Separation of Powers, and Customary International Law*, 121 Harv. L. Rev. 1215, 1215 (2008) 8

Registration Processing Times,
https://www.copyright.gov/registration/docs/processing-times-faqs.pdf (last visited August 31, 2018) 12, 23

Restatement (Third) of the Foreign Relations Law of the United States § 114 (1987) 8

S. Ct. R. 37.6 1

Sandra Edelman & Fara Sunderji, *Delay in Filing Preliminary Injunction Motions: 2015 Edition*, 105 THE TRADEMARK REPORTER 1012 (2015) 19

Special Handling, https://www.copyright.gov/help/faq/faq-special.html (last visited August 31, 2018) 18

Sterling On World Copyright Law [2015] - Protection Criteria mn. 7.86 10

U.S. Courts, *United States District Courts—National Judicial Caseload Profile* 1 (June 2018), http://www.uscourts.gov/sites/default/files/data_tables/fcms_na_distprofile0630.2018.pdf (last visited August 31, 2018) 23

AMICUS CURIAE BRIEF OF THE INTERNATIONAL TRADEMARK ASSOCIATION IN SUPPORT OF PETITIONER

The undersigned amicus curiae respectfully submits this brief in support of Petitioner.[1]

INTEREST OF THE AMICUS CURIAE

Founded in 1878, amicus curiae The International Trademark Association (INTA) is a not-for-profit organization dedicated to serving its members and society as a trusted and influential advocate for the economic and social value of brands. It supports the advancement of trademarks and related intellectual-property concepts as essential elements of trade and commerce. INTA has more than 7,200 members in 191 countries. Its members include intellectual property owners as well as law firms and other professionals who regularly assist brand owners in the creation, registration, protection, and enforcement of their trademarks and related intellectual property. All INTA members share the goal of promoting an understanding of the

---

[1] Both Petitioner and Respondent have filed blanket consents to the filing of amicus briefs in support of either party. This brief was authored solely by INTA and its counsel. No party or counsel for a party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than amicus curiae, its members, and its counsel made such a monetary contribution to its preparation or submission. *See* S. Ct. R. 37.6.

essential role that brands and related intellectual property play in fostering effective commerce, fair competition, and informed decision-making by consumers.

INTA (formerly known as the United States Trademark Association) was founded in part to encourage the enactment of federal trademark legislation after the invalidation on constitutional grounds of the United States' first trademark act. Since then, INTA has been instrumental in making recommendations and assisting legislators in connection with almost all major trademark legislation and, more recently, legislation involving other forms of intellectual property. INTA also participates as amicus curiae in numerous cases involving significant trademark and related intellectual property issues. INTA members are frequent parties in a wide variety of intellectual property-related litigation as both plaintiffs and defendants.

INTA has a particular interest in this case because the question presented – whether a copyright owner may commence an infringement suit after delivering the proper deposit, application, and fee to the Copyright Office, but before the Register of Copyrights has acted on the application – concerns imposing additional burdens on INTA members and other intellectual property owners before they may enforce and protect their rights.

Over the years, INTA has expanded from looking at trademark law in isolation to considering how other areas of intellectual property law may complement the protections trademark law provides to brand owners. Its Mission Statement expressly refers to "supporting trademarks and related intellectual property (IP) to foster consumer trust, economic growth, and innovation."[2]

INTA standing committees on copyright and right of publicity, which are comprised of both leading outside counsel and preeminent senior in-house counsel from companies all over the world, have become a critical part of INTA's mission to support intellectual property in order to foster consumer trust, economic growth, and innovation. INTA has extended its reach into these complementary areas of law because it has become increasingly clear that intellectual property issues do not present themselves in neat categories in the real world. To the contrary, it would not be unusual for a party to seek to protect its brand by bringing trademark claims based on a word mark and copyright claims based on infringement of its logo, product packaging, or advertising content. The rule favored by the respondent would delay a brand owner's ability to promptly bring all such related

---

2 INTA Mission Statement, http://www.inta.org/Governance/Pages/StrategicPlan.aspx (last visited August 31, 2018).

claims simultaneously. This is particularly harmful due to the frequent need for immediate injunctive relief.

Finally, INTA is vitally interested in this case because it is an international organization with members around the world. As an international organization, one of INTA's concerns and central policies has always been to promote the harmonization of intellectual property laws. The Berne Convention for the Protection of Literary and Artistic Works ("Berne") fosters and promotes reduced formalities in copyright law, for all signatory nations, such that creators of copyrightable works can more easily protect their rights. Such international harmonization of intellectual property law is critical in today's global economy because works and products are often sold, viewed, read, or otherwise distributed in multiple jurisdictions simultaneously. To have fundamentally different intellectual property regimes in different jurisdictions unnecessarily complicates and burdens the efforts of intellectual property owners and creators to protect their interests and those of the consuming public. The United States is a signatory to Berne, yet the Copyright Act, no matter how interpreted, imposes more burdens on the creators of United States works than creators of foreign works, putting domestic works at a disadvantage. The interpretation that INTA advocates, consistent with the Petitioner's arguments, would minimize this

disadvantage and try to create a more harmonious framework for international copyright protection.

SUMMARY OF ARGUMENT

Because the meaning of 17 U.S.C. § 411(a), providing that lawsuits for infringement of any United States copyright shall not be instituted until "registration of the copyright claim has been made," is ambiguous, it should be interpreted to be consistent with the Berne Convention for the Protection of Literary and Artistic Works ("Berne"), to which the United States acceded in 1988. Article 5(2) of Berne requires that "[t]he enjoyment and the exercise of [copyright] rights shall not be subject to any formality . . . ." In light of the Congressional intent manifested by Congress's accession to Berne, Section 411(a) should be construed to minimize formal obstacles to enforcing copyrights: Registration of a claim to copyright is "made" when an application, deposit, and fee are filed. This interpretation (hereinafter the "application interpretation") best effectuates Congress's intent when it acceded to Berne. By contrast, the interpretation proposed by Respondent (hereinafter the "registration interpretation") requires that a copyright claimant wait many months for the Copyright Office to issue a certificate, as it does 97 percent of the time. This is a meaningless formality that Congress could not have intended.

ARGUMENT

A. Because the Meaning of Section 411(a) Is Unclear, the Court Should Construe the Statute To Be Consistent with the Intent of Congress to Adhere to International Treaties, in this Case Berne.

The meaning of Section 411(a) is ambiguous. Although INTA supports Petitioner's interpretation of Section 411(a), the circuit split on this issue is the best evidence that the meaning of the section is uncertain and that this Court must look to the broader context to discern its meaning.

When, as here, statutory language proves unclear, this Court discerns the statute's meaning by looking to the purpose and "broader context of the statute as a whole." *Robinson v. Shell Oil Co.*, 519 U.S. 337, 341, 117 S. Ct. 843, 136 L. Ed. 2d 808 (1997).

Some circuits have interpreted Section 411(a) to mean that a copyright claimant may file suit upon submitting an application, deposit, and fee to the Copyright Office (the application interpretation), while others have held that a copyright claimant must await the Copyright Office's decision to grant or deny registration, which can take several months, before it may sue (the registration interpretation).

The circuits disagree because the statute is ambiguous. Because the statutory language is uncertain, it should be construed to effectuate the intent Congress expressed when it acceded to Berne's fundamental provision—that there be no formal obstacles to enforcing copyrights.

A 210-year-old canon of statutory construction holds that "an act of Congress ought never to be construed to violate the law of nations if any other possible construction remains." *Murray v. Schooner Charming Betsy*, 6 U.S. (2 Cranch) 64, 118 (1804); *see also* Restatement (Third) of the Foreign Relations Law of the United States § 114 (1987); Note, *The Charming Betsy Canon, Separation of Powers, and Customary International Law*, 121 Harv. L. Rev. 1215, 1215 (2008) (discussing the "deeply embedded" canon of construction).

It is important to ensure that the country is engaged in "full participation in the dominant system of international copyright protection." *Golan v. Holder*, 565 U.S. 302, 335, 132 S. Ct. 873, 181 L. Ed. 2d 835 (2012). This includes "exemplary compliance" with the United States' international obligations. *Id. See also Subafilms, Ltd. v. MGM-Pathe Commc'ns Co.*, 24 F.3d 1088, 1097 (9th Cir. 1994) (en banc) (warning about an approach that might "undermine Congress's objective of achieving 'effective and harmonious copyright laws among all nations.'"). Accordingly, judicial rulings that could

ignore our international obligations would undercut the country's positions and the perception that the United States is a trusted partner in multilateral endeavors. *See Vimar Seguros y Reaseguros, S.A. v. M/V Sky Reefer*, 515 U.S. 528, 539, 115 S. Ct. 2333, 132 L. Ed. 2d 462 (1995); *Benz v. Compania Naviera Hidalgo, S.A.*, 353 U.S. 138, 147, 77 S. Ct. 699, 1 L. Ed. 2d 709 (1957) (cautioning against courts "run[ning] interference in such a delicate field of international relations . . . [without] the affirmative intention of the Congress clearly expressed").

The application interpretation, which is more consistent with international copyright law than the registration interpretation, protects the enforcement rights of copyright claimant, and comports with the language and intent of the Copyright Act.

B. The Registration Interpretation Is Contrary to Berne.

(1) Berne stands for the principle of freedom from formalities.

The United States acceded to Berne[3] on October 31, 1988. Berne's principle purpose is

---

[3] Berne Convention for the Protection of Literary and Artistic Works of September 9, 1886, completed at PARIS on May 4, 1896, revised at BERLIN on November 13, 1908, completed at BERNE on March 20, 1914,
revised at ROME on June 2, 1928, at BRUSSELS on June 26, 1948, at STOCKHOLM on July 14, 1967, and at PARIS on July 24, 1971, and amended on September 28, 1979.

freedom from formalities. Berne Article 5(2) provides "[t]he enjoyment and the exercise of [copyright] rights shall not be subject to any formality . . . ." The underlying principle is to make the attachment and enforcement of copyright as simple as possible. Consequently, only a small number of countries still require formalities to be fulfilled as a pre-condition of bringing an action.[4]

(2) The registration interpretation is inconsistent with Berne.

The United States was not an initial signatory to Berne. Rather, for more than a century, the United States refused to join Berne, primarily because the United States, unlike other developed countries, required certain formalities as a precondition to copyright protection. Intending to bring United States law into conformity with international norms, Congress amended and modified the Copyright Act so that citizens could enjoy the international benefits of Berne participation.

To that end, Congress included several provisions in the Copyright Act to harmonize it with Berne's purpose and intent. First, the Act provides that copyright protection attaches at the time a work is created, regardless of whether it is registered,

---

[4] *See Sterling On World Copyright Law* [2015] - Protection Criteria mn. 7.86.

omitting administrative formalities for copyright protection. 17 U.S.C. § 302(a) ("[c]opyright in a work . . . subsists from its creation"); 17 U.S.C. § 408(a) ("registration is not a condition of copyright protection"). In addition, Section 411(a), requiring that registration of the copyright claim "has been made" as a prerequisite to suit, specifically exempts foreign works. 17 U.S.C. § 411(a). Therefore, the enforcement obstacles imposed by Section 411(a) (under both the registration and application interpretations) only apply to United States works—owners of foreign works are exempted from even filing an application before filing suit. While Section 411(a)'s exemption of foreign works was intended to comply with Berne's requirements, the registration interpretation adopted by the Eleventh Circuit in the decision below still creates an obstacle for owners of United States works that contravenes Berne's purpose.

The fundamental question for this Court is whether Congress intended that the obstacles that Section 411(a) imposes on United States copyright owners be large (the registration interpretation) or small (the application interpretation). Given Congress's efforts to reduce formalities in compliance with Berne, the answer is the latter—Congress intended to minimize formalities. It is not likely that Congress had the inconsistent intention to minimize (indeed to completely eliminate) obstacles to

enforcing foreign copyrights, but to maximize obstacles to enforcing United States copyrights.

It is more consistent with Berne to conclude that Congress intended to maintain a minimal registration requirement for United States copyrights, as reflected in the application interpretation of Section 411(a). Certainly this interpretation is more consistent with Congress's intent when acceding to Berne and implementing amendments necessary to make that possible. Requiring owners of United States works to even apply for a copyright registration prior to enforcing their rights imposes a formality that contravenes Berne. But, given the minimal application fee and the ease with which an application, deposit, and fee can be submitted to the Copyright Office, the burden of the application requirement is relatively minor and certainly closer to the enforcement rights afforded foreign copyright owners.

By contrast, the registration interpretation of Section 411(a) maximizes the formal barriers to copyright enforcement. This approach is the antithesis of Berne. Requiring a claimant to wait several months or face the financial burden of paying an $800 special handling fee to be able to enforce its rights turns Berne on its head.[5] Further, while

---

[5] *See* Copyright.gov, *Registration Processing Times*, https://www.copyright.gov/registration/docs/processing-times-

Sections 302(a) and 408(a) comply with Berne by providing that copyright ownership attaches upon creation of a work (without formalities), the full value and purpose of copyright ownership cannot be achieved if not accompanied by enforcement rights. *See Washingtonian Publ'g Co. v. Pearson*, 306 U.S. 30, 40, 59 S. Ct. 397, 83 L. Ed. 470 (1939) ("Without right of vindication a copyright is valueless.")

The registration interpretation imposes the type of burdensome formalities that Congress intended to eliminate when acceding to Berne. It is unlikely that Congress intended to eliminate formal obstacles for foreign copyright owners while maintaining substantial obstacles for owners of United States works. Rather, it is more plausible that Congress intended that United States works should face only minimal obstacles to enforcement consistent with a registration system. That minimal approach is reflected in the application interpretation of Section 411(a).

---

faqs.pdf (last visited August 31, 2018). *See also* Copyright.gov, *Fees*, https://www.copyright.gov/about/fees.html#handling (last visited August 31, 2018).

C. The Registration Interpretation Deprives Copyright Owners of Important Enforcement Rights.

(1) The registration interpretation creates an obstacle to enforcing copyright interests that is not required to enforce trademark rights.

For brand owners, the registration interpretation is additionally problematic because it imposes obstacles to copyright enforcement that are not present for trademark enforcement. There are many instances, including with respect to logos and designs, when copyright and trademark protection overlap. And, there are other instances, including with respect to counterfeit goods and online infringement, when a party may separately infringe a brand owner's trademark rights (e.g., product packaging or a domain name) and copyright interests (e.g., product manuals or website content). In those instances, brand owners often must assert both copyright and trademark claims.

Although brand owners routinely seek to register their logos and other trademarks with the United States Patent and Trademark Office, registration is not a prerequisite to suit. Rather, brand owners can enforce their common law trademark rights under the Lanham Act without first obtaining, or even applying for, a registration. *See* 15 U.S.C. § 1125. Thus, even if brand owners have not registered their

marks, they have the right to enforce their trademark rights in federal court, including by seeking injunctive relief.

This is not so for copyrights under the registration interpretation. Under that interpretation, copyright owners who have not registered their works must pay a substantial special handling fee to expedite registration or delay their enforcement by several months while waiting for the Copyright Office to grant (or deny) registration. Thus, under the registration interpretation, brand owners needing to quickly enforce their trademark and copyright interests may be barred from doing so, potentially resulting in disadvantageous delay or the pursuit of multiple lawsuits involving overlapping acts of infringement. This approach to enforcement is not only inefficient. It also creates a risk of inconsistent outcomes and may otherwise impact the outcome on the merits.

By contrast, under the application interpretation, brand owners can quickly attain the right to enforce their copyrights by submitting an application, deposit, and fee and thus simultaneously enforce their copyrights and trademarks without unnecessary delay or excessive administrative costs. The application interpretation therefore benefits both brand owners and the efficient administration of justice.

(2) The registration interpretation deprives copyright owners of expeditious enforcement rights.

The registration interpretation harms copyright claimants who need to act quickly when (1) the statute of limitations expires within three years; or (2) irreparable harm caused by infringement requires a temporary restraining order or preliminary injunctive relief. In both cases, a delay of several months (or even several days) can deprive copyright claimants of the ability to enforce their rights. The alternative of paying a hefty fee for special handling discourages enforcement. Non-profit entities, small businesses, and individuals of modest means would feel this loss of enforcement rights most keenly, especially when numerous infringed works require individual registrations (and special handling fees).

(3) The registration interpretation can deprive copyright claimants of the ability to enforce their rights when the expiration of the statute of limitations is approaching.

A critical downside of the registration interpretation is that it may deprive copyright claimants of the ability to enforce their rights when the Copyright Act's three-year statute of limitations will expire during the multi-month period it takes the Copyright Office to make a registration decision.

Copyright claimants in such situations face two problematic options: (1) expedite processing of the application by paying a special handling fee which, at $800, is twice the $400 filing fee for a federal lawsuit (without any in forma pauperis waiver) and nearly 15 times the standard fee for a copyright registration application; or (2) forego their rights to enforce their copyrights. While a special handling fee may be an acceptable cost to some claimants in some situations, such a fee could deter many claimants from enforcing their rights entirely, especially with respect to claimants with limited resources or who are seeking to protect multiple copyrighted works.

The statute of limitations for copyright infringement runs from three years after a claim has accrued. 17 U.S.C. § 507. Accrual occurs when an infringement is discovered. *See Petrella v. Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962, 1969 n.4, 188 L. Ed. 2d 979 (2014) (noting that nine Courts of Appeals have adopted the discovery rule in copyright infringement cases). This Court held in *Petrella* that a copyright owner can only recover damages for the three-year period leading up to suit. *See id.* at 1973 ("[A] successful [copyright] plaintiff can gain retrospective relief only three years back from the time of suit. No recovery may be had for infringement in earlier years."). Under the registration interpretation, the statute of limitations might run before the Copyright Office makes a registration decision, or damages might be limited

depending on the scope of infringement in the three years prior to a registration decision and concomitant institution of suit. Such a result would be inequitable in light of the fact, as discussed below, that the Copyright Office issues registrations certificates in 97 percent of cases, and claimants have the right to file suit upon the denial of a registration.

Even in cases of special handling, the Copyright Office has no statutory obligation to issue a registration decision within any period of time, and the statute of limitations could run in many cases even when special handling is requested at significant cost.[6]

(4) The registration interpretation could deprive copyright claimants of the ability to promptly obtain temporary restraining orders or preliminary injunctive relief.

The registration interpretation also hurts copyright claimants who need temporary restraining orders or preliminary injunctions to stop irreparable

---

[6] *See* Copyright.gov, *Special Handling*, https://www.copyright.gov/help/faq/faq-special.html (last visited August 31, 2018) ("Once a request for special handling is received and approved, every attempt is made to process the claim or recordation within five working days. However, no guarantee is made that the work can be processed within this time.").

harm caused by copyright infringement. When an infringing advertisement will air in two days or an infringing artwork will be shipped out of the country in four days, even special handling would not allow for a registration decision in time. In such cases, the registration interpretation serves no useful purpose but to deprive copyright owners of their enforcement rights.

Additionally, the delay caused by the registration interpretation could prevent a copyright owner from obtaining injunctive relief. Some courts have held that delay in seeking an injunction counters a finding of irreparable harm in the copyright context. *See Garcia v. Google, Inc.*, 786 F.3d 733, 746 (9th Cir. 2015) (five-month delay in seeking to enjoin video weighed against finding of irreparable harm); *see also Clonus Assocs. v. DreamWorks, LLC*, 417 F. Supp. 2d 248 (S.D.N.Y. 2005) (delay of less than one month, but after film release, weighed against finding of irreparable harm).[7]

Accordingly, by requiring claimants to wait several months for a registration decision before

---

[7] Sandra Edelman & Fara Sunderji, *Delay in Filing Preliminary Injunction Motions: 2015 Edition*, 105 THE TRADEMARK REPORTER 1012 (2015), http://www.inta.org/TMR/Documents/Volume%20105/TMR_Vol105_No5_Edelman_Sunderji.pdf.

filing suit, the registration interpretation could prevent claimants from obtaining preliminary injunctive relief. The application interpretation avoids this result and allows copyright claimants to quickly and effectively enforce their rights, just as Berne and Congress intended.

D. Requiring the Issuance or Denial of a Registration Decision Is Bad Policy and Makes No Practical Sense.

(1) The delay caused by the registration interpretation serves no practical purpose.

The delay (or substantial expense) imposed by the registration interpretation not only contravenes Berne, but it does so without providing any real benefit to copyright owners, the judicial system, or the Copyright Office. Any minimal benefit courts and litigants may derive from knowing the Copyright Office's pre-suit position on copyrightability is outweighed by the burdens imposed by the registration interpretation.

Requiring copyright claimants to wait months to sue (or pay a burdensome special handling fee) serves little purpose because the Copyright Act explicitly permits claimants to file suit whether a registration is granted or denied. See 17 U.S.C. § 411(a). The only distinction is that when a registration is denied, the copyright plaintiff must serve notice of its lawsuit and a copy of the

complaint on the Register of Copyrights, who has the option to intervene on the issue of registrability. *Id.* Because the denial of a registration does not deprive litigants of the right to sue, it makes no practical sense for the pendency of a decision to strip claimants of their enforcement rights. Under the registration interpretation, claimants are not required to wait until a certificate is issued; rather they are forced to wait until the Copyright Office makes a decision. Depriving United States copyright claimants of their enforcement rights based on nothing more than the administrative delays of a government office is inequitable, and contravenes Berne.

The Copyright Office grants copyright registration certificates 97 percent of the time.[8] This statistic demonstrates that the Copyright Office's registration decisions are more an administrative formality than an in-depth legal analysis regarding copyrightability. The 97 percent grant rate calls into question the notion that courts benefit from having the opinion of the Copyright Office before lawsuits begin. On the contrary, at 97 percent, the decision to

---

[8] Melville B. Nimmer, NIMMER ON COPYRIGHT, § 7.16[B][3][b][ii] (citing Brief of the United States, at 4 n.2, *Reed Elsevier, Inc. v. Muchnick* 559 U.S. 154, 130 S.Ct. 1237, 176 L. Ed. 2d 18 (2010)). *See also* U.S. Copyright Office, *Fiscal 2017 Annual Report* 4, https://www.copyright.gov/reports/annual/2017/ar2017.pdf (last visited August 31, 2018).

grant a registration looks like a rubber stamp. This is just the kind of administrative hurdle—imposing great burden but providing little benefit—that Berne seeks to eliminate.

Requiring litigants and courts to wait for the Copyright Office makes even less sense because courts are not bound by the Copyright Office's decisions as to copyrightability. Indeed, a registration decision issued before or within five years of publication of a work is prima facie evidence of the validity of the copyright and facts stated in the certificate. 17 U.S.C. § 410(c). But for works registered more than five years after publication, courts have discretion to decide what, if any, weight should be given to the certificate. *Id.* Even when a registration certificate constitutes prima facie evidence of validity, courts may still reject that finding and find registered material to be uncopyrightable. *See Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417, 428 (4th Cir. 2010) ("the Copyright Office's practice of summarily issuing registrations . . . counsels against placing too much weight on registrations as proof of a valid copyright"); *see also ATCS Int'l LLC v. Jefferson Contracting Corp.*, 807 F. Supp. 2d 516, 518 (E.D. Va. 2011) ("Under these circumstances, the presumption of copyright validity that attaches to the CSDs by virtue of their registration does not clearly establish a valid, protectable copyright."). Because the Copyright Office's decisions are not

binding on courts, requiring litigants and courts to await those decisions before filing suit makes little practical sense. Moreover, to the extent courts applying the application interpretation would like to know the Copyright Office's position on registrability before making certain rulings in litigation, they are entitled to institute a stay (or delay their ruling) until the Copyright Office renders a decision. The application interpretation thus enables claimants facing a statute of limitations deadline to file suit and preserve their claims without having to wait for a Copyright Office decision.

Also, in most cases where the application interpretation is applied, the Copyright Office will have made a registration decision well before the case reaches trial. On average, civil cases in United States district courts reach trial approximately 27 months after filing.[9] Depending on various factors, the Copyright Office, on average, takes between 7 and 16 months to issue a registration certificate.[10]

Therefore, while it can take considerable time for the Copyright Office to make a registration decision,

---

[9] U.S. Courts, *United States District Courts—National Judicial Caseload Profile* 1 (June 2018), http://www.uscourts.gov/sites/default/files/data_tables/fcms_na_distprofile0630.2018.pdf (last visited August 31, 2018).

[10] *See* Copyright.gov, *Registration Processing Times*, https://www.copyright.gov/registration/docs/processing-times-faqs.pdf (last visited August 31, 2018).

when an application is filed shortly before a lawsuit is filed, the Copyright Office would generally make a registration decision well before the average time to trial. In those cases in which the Copyright Office has not yet made a decision before trial, courts are at liberty to continue the trial date, if appropriate, until the Copyright Office makes a decision. In any event, delaying trial is far more equitable than delaying the institution of suit, because, as set forth above, delaying the institution of suit can deprive claimants of their enforcement rights entirely.

E. The Plain Language Of the Copyright Act Supports the Application Interpretation.

The application interpretation is supported by the plain language of the Copyright Act. The Copyright Act provides: "no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title." 17 U.S.C. § 411(a). Petitioner correctly reads "registration . . . has been made" to mean that an application, deposit, and fee have been filed. This interpretation is buttressed by the fact that the very next sentence of Section 411(a) explicitly provides that an applicant may file suit if the Copyright Office denies its application. 17 U.S.C. § 411(a). Thus, as Petitioner notes, "has been made," under the application interpretation, refers to action by the copyright claimant rather than the Copyright

Office. Otherwise, the Copyright Act is attaching too much consequence to the pace at which the Copyright Office does its job, while depriving even diligent claimants of the ability to control their own destinies. Petitioner's reading, and the application interpretation, logically comport with the language and purpose of the Copyright Act, as well as Berne's purpose and intent.

Interpreting "has been made" to mean the submission of an application, deposit, and fee (the application interpretation) serves the Copyright Act (and Berne's) purpose of removing unnecessary formalities to securing and enforcing copyright interests. The Copyright Act clearly aims to harmonize with Berne by providing that copyright in a work subsists from the time of creation (without the need for registration) and by exempting foreign works from even the application requirement before suit can be filed. *See* 17 U.S.C. § 302(a) ("[c]opyright in a work . . . subsists from its creation"); 17 U.S.C. § 408 (a) ("registration is not a condition of copyright protection."); 17 U.S.C. § 411(a) (excluding foreign works from pre-suit registration requirement). It follows, then, that the Act would not impose on United States copyright owners the unnecessary formality of having to obtain a registration certificate (or denial) before a lawsuit can be instituted. Rather, the accession to Berne reflects Congressional intent to minimize administrative burdens. Accordingly, Section 411(a) logically only

requires the submission of a deposit, application, and fee in order for a party to file suit to enforce its copyrights.

CONCLUSION

The Court should rule in favor of Petitioner.

September 4, 2018

Respectfully submitted,

NOEL M. COOK
OWEN WICKERSHAM & ERICKSON, P.C.
455 Market St., Suite 1910
San Francisco, CA 94105
(415) 882-3200

JASON P. BLOOM
HAYNES AND BOONE, LLP
2323 Victory Avenue,
Suite 700
Dallas, Texas 75219
(214) 651-5655

LAWRENCE K. NODINE
Counsel of Record
BALLARD SPAHR LLP
999 Peachtree Street
Atlanta, Georgia 30309
678-420-9422
nodinel@ballardspahr.com

COUNSEL FOR AMICUS CURIAE
THE INTERNATIONAL TRADEMARK ASSOCIATION